

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY**

PACIRA PHARMACEUTICALS, INC., and
PACIRA BIOSCIENCES, INC.,
Plaintiffs,

v.

eVenus PHARMACEUTICALS
LABORATORIES, INC., JIANGSU
HENGRUI PHARMACEUTICALS CO.,
LTD., and FRESENIUS KABI USA, LLC,
Defendants.

Civil Action No. 2:21-cv-19829
Civil Action No. 2:22-cv-00718
(consolidated)

Assigned to:
Judge Madeline Cox Arleo
Magistrate Judge José R. Almonte

FINAL JUDGMENT

WHEREAS, Plaintiffs Pacira Pharmaceuticals, Inc. and Pacira Biosciences, Inc. (collectively, “Pacira or Plaintiffs”) filed the above-referenced consolidated actions against Defendants eVenus Pharmaceuticals Laboratories, Inc. (“eVenus”), Jiangsu Hengrui Pharmaceuticals Co., Ltd. (“Jiangsu Hengrui”), and Fresenius Kabi USA, LLC (“Fresenius”) (collectively, “Defendants”) for infringement of U.S. Patent Nos. 11,033,495 (the “’495 patent”) and 11,179,336 (the “’336 patent”) in connection with Jiangsu Hengrui’s submission of Abbreviated New Drug Application (“ANDA”) No. 214348 to the U.S. Food and Drug Administration (“FDA”), seeking approval to market bupivacaine liposome injectable suspension, 266 mg/20 mL (13.3 mg/mL) and bupivacaine injectable suspension, 133 mg/10 mL (13.3 mg/mL), prior to the expiration of the ’495 patent and the ’336 patent.

WHEREAS, the Court previously dismissed (ECF No. 237¹) with prejudice Counts III, IV, V, and VI of Plaintiffs' First Amended Complaint (No. 22-cv-00718, ECF No. 10), alleging infringement of the '336 patent;

WHEREAS, the Court previously dismissed (ECF No. 237) without prejudice Defendants' Counterclaims for Declaratory Judgment of Noninfringement and Invalidity of the '336 patent in Defendants' Answer to First Amended Complaint, Affirmative Defenses, and Counterclaims (No. 22-cv-00718, ECF No. 17, Third, Fourth, and Fifth Claims for Relief; ECF No. 134, Third, Fourth, and Fifth Claims for Relief);

WHEREAS, the Court held a five (5)-day bench trial in the above-referenced actions in February 2024, which trial proceedings were limited to addressing claim 7 of the '495 patent;

WHEREAS, following trial, the parties submitted post-trial briefs and proposed findings of fact and conclusions of law (ECF Nos. 365-371, 395-396);

WHEREAS, after considering the parties' post-trial submissions and hearing closing arguments on May 7, 2024, the Court issued its Opinion (ECF No. 403) and Order (ECF No. 404) on August 9, 2024; therein, the Court found that claim 7 of the '495 patent is invalid as obvious and anticipated;

NOW THEREFORE, IT IS HEREBY ORDERED, ADJUDGED, AND DECREED that:

1. The Court has jurisdiction over the parties and subject matter of the above-referenced consolidated actions.
2. For the reasons set forth in the Court's August 9, 2024 Opinion (ECF No. 403), final judgment is hereby entered in favor of Defendants and against Plaintiffs on the basis that claim 7 of the '495 patent is invalid as anticipated and obvious.

¹ Unless otherwise noted, docket entries are for C.A. No. 2:21-cv-19829.

3. For the reasons set forth in the Court's August 9, 2024 Opinion (ECF No. 403), final judgment is hereby entered in favor of Defendants and against Plaintiffs on Defendants' Counterclaims for Declaratory Judgment of Invalidity of the '495 patent (ECF No. 134, Second Claim for Relief; No. 22-cv-00718, ECF No. 17, Second Claim for Relief) on the basis that claim 7 of the '495 patent is invalid as obvious and anticipated.

4. In light of the Court's ruling on the defenses and counterclaims of invalidity based upon obviousness and anticipation, the Court has not reached, and is not deciding, Defendants' additional defenses of invalidity based upon lack of enablement, non-infringement, or unenforceability based on inequitable conduct presented at trial.

5. Defendants' counterclaims for Declaratory Judgment of Non-infringement of the '495 Patent (No. 22-cv-00718, ECF No. 17, First Claim for Relief; ECF No. 134, First Claim for Relief) are dismissed without prejudice as moot, subject to reinstatement upon a remand from an appeal of this Final Judgment.

6. Defendants' Declaratory Judgment of Unenforceability of the '495 Patent (ECF No. 134, Sixth Claim for Relief) is dismissed without prejudice as moot, subject to reinstatement upon a remand from an appeal of this Final Judgment.

7. In the event that Pacira files an appeal from this Final Judgment, any motion for attorneys' fees and/or costs (i) under Federal Rule of Civil Procedure 54(d), (ii) to which Defendants contend they are entitled based on a finding that the case is exceptional under 35 U.S.C. § 285, or (iii) as otherwise permitted by the Court, shall be considered timely filed, if filed and served within thirty (30) days after final disposition and the mandate issues for any such appeal; and

8. In the event Pacira does not file an appeal from this Final Judgment, any motion for attorneys' fees and/or costs (i) under Federal Rule of Civil Procedure 54(d), (ii) to which Defendants contend they are entitled based on a finding that the case is exceptional under 35 U.S.C. § 285, or (iii) as otherwise permitted by the Court, shall be considered timely filed, if filed and served within thirty (30) days after the expiration of the time for filing a notice of appeal under Federal Rules of Appellate Procedure 3 and 4.

Dated: August 16, 2024

/s/ Cynthia S. Betz

Cynthia S. Betz

McCarter & English, LLP

Four Gateway Center

100 Mulberry St.

Newark, NJ 07102

Telephone: (973) 622-4444

Thomas P. Scrivo

O'Toole Scrivo, LLC

14 Village Park Road

Cedar Grove, NJ 07009

Telephone: (973) 239-5700

tscrivo@oslaw.com

Michael T. Zoppo

NJ Bar No: 016292004

Fish & Richardson P.C.

7 Times Square, 20th Floor

New York, NY 10038

Telephone: (212) 765-5070

Facsimile: (212) 258-2291

zoppo@fr.com

Corrin N. Drakulich (*pro hac vice*)

Fish & Richardson P.C.

1180 Peachtree Street NE, 21st Floor

Atlanta, GA 30309

Telephone: (404) 892-5005

Facsimile: (404) 892-5002

drakulich@fr.com

Deanna J. Reichel (*pro hac vice*)

Fish & Richardson P.C.

60 South 6th Street, Suite 3200

Minneapolis, MN 55402

Telephone: (612) 335-5070

Facsimile: (612) 288-9696

reichel@fr.com

Karrie Wheatley (*pro hac vice*)

Fish & Richardson P.C.

909 Fannin Street, Suite 2100

Houston, TX 77010

/s/ Eric I. Abraham

Eric I. Abraham

Hill Wallack LLP

21 Roszel Road

Princeton, NJ 08543

(609) 924-0808

OF COUNSEL:

Daryl L. Wiesen

Kevin J. DeJong

Kathleen McGuinness

Andrew McDonough

Goodwin Procter LLP

100 Northern Avenue

Boston, MA 02210

(617) 570-1156

DWiesen@goodwinlaw.com

kdejong@goodwinlaw.com

KMcGuinness@goodwinlaw.com

AMcDonough@goodwinlaw.com

*Attorneys for Defendants eVenus
Pharmaceuticals Laboratories, Inc., Jiangsu
Hengrui Pharmaceuticals Co., Ltd., and
Fresenius Kabi USA, LLC*

Telephone: (713) 654-5300
Facsimile: (713) 652-0109
wheatley@fr.com

Jonathan E. Singer (*pro hac vice*)
FISH & RICHARDSON P.C.
12860 El Camino Real, Suite 400
San Diego, CA 92130
Telephone: (858) 678-5070
Facsimile: (858) 678-5099
singer@fr.com

*Attorneys for Plaintiffs Pacira Pharmaceuticals,
Inc., and Pacira BioSciences, Inc.*

8/27/24

SO ORDERED

Madeline Cox Arleo, U.S.D.J.